

### REMARKS/ARGUMENTS

The processes of the instant invention are directed to improved production of card bodies and are especially suited for the production of smart cards. The instant invention solves a need in the art for a process for making smart cards that reduces the occurrence of damage to sensitive electronic components during the production process. The state of the art at the time of the Applicant's invention was to use thermoplastic materials that require high temperature and/or pressure during processing. Such conditions can damage electronic components. The instantly claimed processes reduce the likelihood of damage to electronic parts by using an adhesive with a viscosity of 100 mPa·s to 100,000 mPa·s which allows use of lower process temperatures and pressures.

Claims 7-18 are pending. Claim 7 is amended. The basis for the amendment can be found, for example, at page 12, lines 13-15. No claims are added or canceled. All claims stand rejected as anticipated and/or made obvious by certain art. Applicants traverse these rejections.

Applicants note that in a number of the rejections the Office has used a related U.S. patent or a machine translation as a substitute for cited non-English language art. While not affirming the accuracy of these documents as accurate translations, Applicants have used these documents, as provided by the Patent Office, in formulating our response.

Claims 7-10, 13, and 16 stand rejected under 35 U.S.C. § 102(b) as allegedly anticipated by PCT Application No. WO 96/20252 (the 252 application) with this application being represented by U.S. Patent No. 5,776,406 (the 406 patent) as a translation for German language PCT application. While not agreeing with the rejection, Applicants have amended the "card body" language in claim 7 to read "transponder or smart card body." The 406 patent, however, does not disclose or suggest a process for the production of smart cards or transponders. Furthermore, the example in the 406 patent is directed to the production of PVC cable. Such an end use is remote from the instant claims. The standard for anticipation under §102 is one of strict identity and, as discussed above, the disclosure of the 406 patent falls well short of this standard. Applicants respectfully request reconsideration and withdrawal of the rejection.

Claims 7 and 16 stand rejected under 35 U.S.C. § 102(b) as allegedly anticipated by JP 05105805 (the 805 application). The 805 application is directed to a process that requires fillers such as silica or glass fiber (see, for example, paragraph 0012 of the translation). Such fillers are not required by the instantly claimed inventions. For at least this reason, the rejection falls short of the strict identity requirement. Applicants respectfully request reconsideration and withdrawal of the rejection.

Claims 7-11 and 13-18 stand rejected as allegedly obvious over U.S. Patent No. 5,350,553 (the 553 patent) in view of the 252 application or the 805 application. The 553 patent, while being directed to smart cards, does not show or suggest a process with in the Applicant's instant claims. It is merely part of the art whose shortcomings the Applicant's invention overcomes. As discussed above, the 805 application requires use of certain filler material not required by the instant invention. As such, even if one were to combine the teaching of the 553 patent with those of the 805 application, one would not arrive at any claimed invention.

Furthermore, absent the Applicant's blueprint, it would not be obvious to combine the art in the way depicted in the Office Action. Before a rejection for alleged obviousness can be predicated on a "combination of references," some motivation to combine the teachings of the prior art must be identified. An invention is not obvious under the patent laws simply because it is theoretically possible-- with the aid of hindsight-- to combine references in a manner that might yield a claimed invention. The prior art itself must suggest the desirability of the modification. *In re Gordon*, 733 F.2d 900, 902, 221 U.S.P.Q. 1125, 1127 (Fed. Cir. 1984). "A critical step in analyzing the patentability of claims pursuant to section 103(a) is casting the mind back to the time of invention, to consider the thinking of one of ordinary skill in the art, guided only by the prior art references and the then-accepted wisdom in the field." *In re Kotzab*, 217 F.3d 1365, 1369, 55 USPQ2d 1313, 1316 (Fed. Cir. 2000). "The invention must be viewed not with the blueprint drawn by the inventor, but in the state of the art that existed at the time." *In re Dembiczak*, 175 F.3d 994, 999, 50 USPQ2d 1614, 1617 (Fed. Cir. 1999) (quoting *Interconnect Planning Corp. v. Feil*, 774 F. 2d 1132, 1138, 227 USPQ 543, 547 (Fed. Cir. 1985)). To establish a *prima facie* case of obviousness, "there must be some teaching, suggestion or motivation in the prior art to make the specific combination that was made by the applicant." *In re Dance*, 160 F.3d 1339, 1343, 48 USPQ2d 1635, 1637

DOCKET NO.: HENK-0022  
Application No.: 09/807,948  
Office Action Dated: July 17, 2003

PATENT

(Fed. Cir. 1998). "In other words, the examiner must show reasons that the skilled artisan, confronted with the same problem as the inventor and with no knowledge of the claimed invention, would select the elements from the cited prior art references for combination in the manner claimed." *In re Rouffet*, 149 F.3d 1350, 1357, 47 USPQ2d 1453, 1458 (Fed. Cir. 1998).

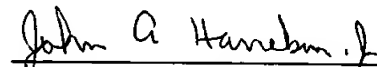
Nothing in the 553 patent teaches or suggests use of the adhesives of the instant inventions. The Office Action appears to rely on a statement in the 553 patent that indicates any suitable injection molding adhesive can be used. At most, this statement is intended to include known smart card adhesives within the scope of the invention. The 406 patent and the 805 application are not directed to smart cards. As such, absent the Applicant's teaching one skilled in the art would lack the required motivation to make the combination asserted by the Office. Applicants respectfully request reconsideration and withdrawal of the rejection.

Claims 7-10 and 12-18 stand rejected as allegedly obvious over JP 09240179 (the 179 application) in view of the 252 application or the 805 application. For reasons entirely analogous to those discussed for the 553 patent, Applicants assert that the rejection should be withdrawn.

Applicants believe that the foregoing constitutes a complete and full response to the Office Action of record. Accordingly, an early and favorable reconsideration of the rejections and an allowance of all of pending claims is earnestly solicited.

Respectfully submitted,

Date: November 12, 2003



John A. Harrelson, Jr.  
Registration No. 42,637

Woodcock Washburn LLP  
One Liberty Place - 46th Floor  
Philadelphia PA 19103  
Telephone: (215) 568-3100  
Facsimile: (215) 568-3439